Remarks

Claims 9, 13, 14 and 31-41 are pending in the present application after entry of the present amendment. Claims 11 and 12 are canceled herein. Claim 9 has been amended to recite that the WISP-1 antagonist comprises a specific monoclonal antibody secreted by a hybridoma deposited with ATCC. Claims 31-41 are added after entry of this amendment.

Amended claim 9 and new claims 31-41 find support in the specification, especially at page 8, line 16, through page 9, line 12, page 80, lines 10-40, and in Examples 10-16, and in the claims as originally filed.

No new matter is added through the amendments presented herein. Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claim Rejections

35 USC §102(b)

Claims 9 and 11-14 are rejected under 35 USC §102(b) as being anticipated by WO 9921998. Claim 9 has been amended. Claims 11 and 12 have been canceled. Amended claim 9, and claims 13-14 dependent thereon, is novel over the cited reference.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, in order to be anticipating, a prior art reference "must be enabling so that the claimed subject matter may be made or used by one skilled in the art". Amgen Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1354 (Fed. Cir. 2003). WO 9921998 fails to provide an enabling disclosure that teaches each and every element of the claims as presently presented.

Claim 9 has been amended to recite a method of inhibiting or neutralizing WISP-1 induction or secretion of HAS2, HA, CD44 or RHAMM in mammalian cells, comprising exposing the mammalian cells to an effective amount of WISP-1 antagonist, wherein the WISP-1 antagonist comprises the 3D11, 11C2, 9C10, 5D4, or 9C11 monoclonal antibody secreted by the hybridoma deposited with ATCC as accession number PTA-4624, PTA-4628, PTA-4626, PTA-4625, or PTA-4627, respectively. WO 9921998 does not teach or suggest the specific antibodies now recited in claim 9. As such, claim 9 is novel over WO 9921998. Applicant requests removal of this rejection.

Similarly, new independent claims 32 and 36 are directed to methods of inhibiting or neutralizing WISP-1 induction or secretion of HAS2, HA, CD44 or RHAMM in mammalian cells, comprising exposing said mammalian cells to an effective amount of WISP-1 antagonist. Claim 32 recites that the WISP-1 antagonist comprises an anti-WISP-1 monoclonal antibody which binds to the same epitope as the epitope to which the specific monoclonal antibodies bind while claim 36 recites that the WISP-1 antagonist comprises a chimeric anti-WISP-1 antibody which specifically binds to WISP-1 polypeptide and comprises a sequence derived from the monoclonal antibodies. WO 9921998 does not teach or suggest such methods.

Conclusion

Applicant believes that the pending claims are in condition for allowance, and respectfully request that a timely Notice of Allowance be issued in this case. If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is encouraged to call the undersigned at the number indicated below.

This response/amendment is submitted with a petition for a 3-month extension of time and fees. In the unlikely event that this document is separated from the transmittal letter or if fees are required, Applicant petitions the Commissioner to authorize charging our Deposit Account 07-0630 for any fees required or credits due and any extensions of time necessary to maintain the pendency of this application.

Respectfully submitted,

GENENTECH, INC.

Date: January 24, 2008

By: Traci H. Ropp

Traci H. Ropp
Reg. No. 44,307
Telephone No. (650) 467-0481